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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,817

10/19/2005

Karl-Heinz Schweikart

2003DE110

3993

25255

7590

09/29/2008

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,817	Applicant(s) SCHWEIKART ET AL.	
	Examiner Patrick D. Niland	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/06, 6/13/06, 1/24/07</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 3-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite “succinamate” though the description of these “succinamates” includes things where the hydrogens of the carbons between the carbonyls are replaced with other moieties. Such things are not technically “succinamates”. It is therefore unclear how much substitution is allowed for the moiety to fall within the scope of the instantly claimed “succinamates” given the broad use of this term in the instant specification without any specific definition or limitations on this term.

B. The instant claim 11 is directed to two statutory classes of invention dependent from claim 1, which is another distinct invention. It is unclear which statutory class of invention is intended since a claim by definition is limited to a single invention. It is further unclear how claim 11 further limits claim 1 since it adds statutory classes of inventions rather than limiting claim 1.

3. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A. Claim 11 does not further limit claim 1 as required by rule. It merely adds statutory classes of invention to the claimed invention.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5938830 Kuo et al. in combination with WO 03/008510 as translated by US Pat. No. 7285592 Harz et al..

Kuo et al. discloses an aqueous colorant composition containing the instantly claimed amounts of the instantly claimed components A, B, and H but does not disclose the instantly claimed component C. See the abstract particularly noting "A variety of pigments, dispersants..."; column 1, lines 13-63, particularly 45-63; column 3, lines 5-67, particularly 24-67, which falls within the scope of the instantly claimed component B; column 4, lines 1-67, particularly 1-18, 25 et seq; column 5, lines 45-67, particularly 48-53, which is the amount of the instantly claimed component B; column 6, lines 1-67, particularly 20-25, 26-43, 44-46, which falls within the scope of the instantly claimed component E and its amount, lines 48-67, more particularly 48-50, which encompasses the instantly claimed component C, and 65-67, which falls within the scope of the amount of the instantly claimed component C; column 7, lines 1-67, particularly 1-15; column 8, lines 1-67, particularly 65 which shows the water to be deionized and to be used in the instantly claimed amounts as are the pigments; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amount of component C in the compositions of Kuo et al. containing the instantly claimed amounts of the remaining

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components encompassed by Kuo and the instant claims and the amounts thereof because Kuo encompasses mixtures of dispersants in the sections discussed above and the ordinary skilled artisan would have expected the benefits of the combinations and amounts of surfactants of Kuo coupled with the benefits of the surfactants of Harz et al. in the final compositions. See Harz et al., abstract, which falls within the scope of the instantly claimed component C; column 1, lines 1-67; column 2, lines 1-12; column 3, lines 5-30; column 4, lines 7-21, 46-65; and the remainder of the document.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amount of component B in the compositions of Harz et al. containing the instantly claimed amounts of the remaining components encompassed by Harz and the instant claims and the amounts thereof because Harz encompasses mixtures of dispersants in the sections discussed above and the ordinary skilled artisan would have expected the benefits of the combinations and amounts of surfactants of Harz coupled with the benefits of the succinamates of Kuo et al. in the final compositions.

There is no probative evidence that any additional components of the prior art colorant dispersions are excluded by “consisting essentially of”, particularly that they materially affect the basic and novel characteristics of the composition and that they are not encompassed by the broad language of the instant claims such as components F and G. The claims are therefore interpreted as encompassing any additional component that might be required of the prior art.

The instant claim 3 continues to encompass 0% since the claim does not otherwise modify the amount of claim 1.

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It would have been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the above discussed compositions in the form of the sets of the instant claims 12-17 because that is the commercially accepted means of supplying such inkjet inks of the cited prior art, as is well known and implied by Kuo, column 1, lines 16-19.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
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